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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,258	11/03/2003	Robert J. Simmons	J-BSIM.1006	3704

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EXAMINER	
LAUX, JESSICA L	

ART UNIT	PAPER NUMBER
3635	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/700,258	SIMMONS, ROBERT J.	
	Examiner	Art Unit	
	Jessica Laux	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of the amendment filed 03/26/2007. Accordingly the drawings and claims have been amended.

Response to Arguments

Applicant's arguments filed 03/26/2007 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the prior art:

Regarding claims 1 and 2 – applicant argues that Dean discloses a beam having a central passage but that the passage is not opened.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an open passage) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claim 5 – applicant argues that the web cannon sear have as spanner portions and channels. Examiner disagrees noting that there is a V-shape channel in the web elements and that the end portions take the form of an I-beam and that the V-shaped channel is a separate feature not necessary to the generally I-beam shape.

In response to applicant's arguments regarding the drawing objections:

The objection stated that there was an abundance of redundant reference characters depicted in the drawings not an abundance drawings.

Applicant claims that all of the features of the invention of clearly depicted in the replacement drawings, however the replacement drawings appear to be an exact copy of the original drawings and therefore do not clear up the issues as presented in the previous office action nor has applicant provided remarks to clarify the drawings. Therefore the objections as presented in the previous action have not been sufficiently addressed and are again presented below.

Applicant argues with respect to figure 1 that the figure is an isometric view, however isometric view show 3-dimensional objects in 3-dimensions not 2-dimensions. Therefore applicant needs to submit a 3-dimensional isometric drawing, since applicant's invention is 3-dimensional. 2-dimentional drawings are sufficient when presented in a top, bottom or side view, but not in isometric view. However, to provide a clear understanding of the inventions features and structural relationships a 3-dimensional drawing must be shown if presented in an isometric view.

Further the replacement drawings do not further clarify or correct the deficiencies of the original drawings regarding insufficient detail to enable one skilled in the art to make and or use applicant's invention. For example lines and dots have been used in the drawing to depict certain features of the invention, but no detailed drawings depicted the actual structure of those features or the structural relationships between all of the elements have been presented. Lines and dots are not acceptable representations of applicants claimed and described features.

In response to applicant's arguments regarding the claim objections:

Applicant argues that the specification clearly and concisely defines the term "spanner portion" on page 3 starting at line 21 and continuing to page 4, line 1. However, examiner notes that the referenced passage merely recites the term "spanner portion" without providing and intended definition or structural limitations to the term. Therefore the term has not been sufficiently defined or clarified.

Drawings

The drawings are objected to because:

The drawings are redundant with an over abundance of reference characters making the drawing figures unclear and messy.

Figure 1 is objected to because it shows all of the features in two dimensions which is inconsistent with the specification and understanding of the invention. In order to overcome this objection the drawings must show the objects of figure one in the proper dimension with the proper detail as described in the specification. (i.e. – reference characters 13a and 13b are described as spanner portions, however the figure shows them as a line of a two dimensional plane). All of the described and claimed features (i.e. the through chase, spanner portions, etc.) must be shown in the drawings in a clear, concise and accurate manner.

Figures 1-4 have not been described in the specification or drawings in such a way as to enable one skilled in the art to understand the invention. Each figure shows a partial drawing of the described features, but the combination of all of the drawings does not provide a clear understanding of the invention as

described and claimed. For example the spanner portions and overload fuses have not been depicted in a way that would enable one skilled in the art to make and understand the invention as claimed and described in the specification.

Claim Objections

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "spanner" is used in the claims, the accepted meaning is "a metal wrench." The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by A.G. Dean (2082792).

Regarding claim 1: Dean discloses an elongate structural chase beam (figure 2), capable of use in a building frame as a unit extending laterally between, and with opposite ends anchored to, a pair of upright columns, and further capable of accommodating the vertical passage of selected building infrastructure through, and generally within the vertical plane containing, the long axis of the beam, said beam comprising: spaced opposite end portions (figure 2, where the beam is a finite object

having a first end and a second end), and an elongate spanner portion (elements 3, 4) extending between and joining operatively with said end portions, and including a central, vertically oriented (in that the passage extends from the top of the beam to the bottom in a vertical direction) through-passage (figures 2 and 3, the space between the spanner portions 3 and 4), referred to as a chase passage, that lies generally about a plane containing the beam's long axis.

Regarding claim 2: Dean discloses an elongate structural chase beam, capable of use in a building frame as a unit extending laterally between, and with opposite ends anchored to, a pair of upright columns, and further capable of accommodating the vertical passage of selected building infrastructure through, and generally within the vertical plane containing the long axis of, the beam, said beam comprising: a pair of longitudinally spaced end portions (figure 2, where the beam is a finite object having a first end and a second end) defining opposite ends of the beam, and a pair of elongate, laterally spaced and generally parallel spanner portions (elements 3 and 4) extending between and having opposite ends operatively joined to said end portions, the space between said spanner portions defining a vertically clear chase passage (figures 2 and 3, the space between the spanner portions 3 and 4) extending as a clear space through the beam generally about a plane containing the beam's long axis.

Further regarding claims 1 and 2: The phrases "adapted for assembly in a building frame as a unit extending laterally between, and with opposite ends anchored to, a pair of upright columns" and "further adapted to accommodate the vertical passage of selected building infrastructure through, and generally within the vertical plane

containing the long axis of, the beam" are recitations of intended use, which do not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus that satisfies the claimed limitations.

Regarding claim 5: The chase beam of claim 2, wherein each said end portion takes the form of an I-beam (as seen in figures 2 and 3), and each said spanner portion includes a channel (as seen in figures 2 and 3, where the outwardly facing portions of elements 3 and 4 have V-shaped channels).

Regarding claim 6: The chase beam of claim 5, wherein each end-portion has spaced flanges (6) with spaced, opposite-side pairs of outwardly facing lateral edges (generally at 1 and 2 of figure 3), said spanner-portion each includes a central web (generally at 3 and 4 of figure 3) and a pair of spaced flanges (6 of the spanner-portion as seen in figure 3) extending from one side of said central web, and said spanner-portions and each end portion are joined in a manner whereby said central webs are anchored to the lateral edges of different ones of associated, opposite-side pairs of said outwardly facing lateral edges, with the flanges in the spanner-portion extending outwardly away from the attached end portion (figure 3).

Claim Rejections - 35 USC § 103

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean (2082792).

Regarding claims 3 and 4: Dean discloses the chase beam of claim 2 above, but does not expressly disclose that at least one of or each of said end portions is formed with an overload fuse. However applicant disclose in the specification on page 4, line 13 and page 5, lines 11-17 that the use of overload fuses in beams in conventional in the art. Therefore it would have been a matter of design choice to one of ordinary skill in the art to include overload fuses in the beams of Dean, for the purpose of protecting against overload, as applicant has not disclosed that such a feature solves a stated problem, is used for a particular purpose, or provides an advantage.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL
06/01/2007

Jeanette Chapman
Primary Examiner

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